

### **REMARKS**

Applicants and Applicants' attorney express appreciation to the Examiner for the courtesies extended during the recent Interview held on June 15, 2004. The remarks presented below are consistent with the remarks presented during the Interview.

Claims 1-35 are pending. As indicated above, claims 10, 24, and 26 have been amended solely to correct minor grammatical errors. Applicants note for the record that the amendments to claims 10, 24, and 26 do not narrow the scope of the respective claims or otherwise evince an intent to surrender any subject matter.

With respect to the declaration filed under 37 C.F.R. § 1.131, the Office Action asserts that 35 U.S.C. § 102(b) bars an applicant from obtaining a patent when the time between conception and filing is more than one year. Applicants respectfully disagree. As correctly quoted in the Office Action, 35 U.S.C. § 102(b) states that an applicant is not entitled to a patent if "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States." There is nothing in 35 U.S.C. § 102(b) to limit the time that may elapse between the conception of an invention and the filing of a patent application.

In reviewing the conditions under which it is appropriate to file a 37 C.F.R. § 1.131 declaration, section 715 of the MPEP states that a 37 C.F.R. § 1.131 declaration may be used "to antedate a reference that qualifies as prior art under 35 U.S.C. 102(e), where the reference has a prior art date under 35 U.S.C. 102(e) prior to applicant's effective filing date, and shows but does not claim the same patentable invention." U.S. Patent No. 6,574,630 to Augustine et al. ("*Augustine*") was filed on August 16, 2000, as a CIP of an application filed on January 28, 2000, and issued on June 3, 2003. Applicants filed on October 4, 2000. Therefore, with respect to Applicants filing date, *Augustine*

qualifies as a prior art reference, if at all, under 35 U.S.C. § 102(e), and may be removed by filing a declaration under 37 C.F.R. § 1.131.<sup>1</sup>

The Office Action also asserts that the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the *Augustine* reference. The declaration, however, relies on a reduction to practice, rather than conception coupled with due diligence, to establish an earlier invention date. MPEP § 715.07. Accordingly, the issue is whether the declaration and supporting exhibits are sufficient to establish a reduction to practice, not whether they are sufficient to establish conception of the invention. Applicants specifically note Sections 1.4 Notification Features in Store, 1.5 DAV Notification Protocol, 1.6 Implementation Decisions, and 1.7 Extended Examples, submitted in Exhibit A, as evidence supporting Applicants' declaration that the claimed subject matter had been reduced to practice. Furthermore, the Performance! and other slides from Exhibit B are also worth noting. Applicants respectfully submit, therefore, that the reasons stated for finding the declaration insufficient are improper and should be withdrawn.

Based on the asserted insufficiency of the declaration, the Office Action rejected claims 1-9 and 19-35 under 35 U.S.C. § 103(a) as being unpatentable over *Augustine* in view of U.S. Patent No. 5,935,211 to Osterman ("*Osterman*"), and rejected claims 10-18 under 35 U.S.C. § 103(a) as being unpatentable over *Augustine* and *Osterman* in view of U.S. Patent No. 6,070,184 to Blount et al. ("*Blount*").

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation . . . to combine reference teachings. Second, there

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<sup>1</sup>Applicants note that since there is no indication the evidence submitted with the declaration was publicly accessible prior to Applicants' filing date (Exhibit A includes a footer showing that it is confidential to Microsoft, and, as indicated in the declaration itself, Exhibit B includes material from an internal Microsoft presentation), the evidence does not constitute a "printed publication" for purposes of 35 U.S.C. §§ 102(a) or 102(b). MPEP § 2128.

must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143. In rejecting each of the pending independent claims, the Office Action asserts that *Augustine's* communicating of electronic messages using SMTP (column 3, lines 45-67) discloses sending notification data using a connectionless protocol to a client system, as recited for example in independent claim 1. *See, e.g.,* Office Action, p. 4 (rejection of claim 1). Applicants respectfully submit, however, that SMTP is not an example of a connectionless protocol as that term is used in Applicants' Specification. Accordingly, as discussed during the Interview and reflected in the Interview Summary, the art of record does not teach connectionless notification. Applicants respectfully submit, therefore, that the rejections of the pending independent claims, and corresponding dependent claims, are improper and should be withdrawn.

Based on at least the foregoing reasons, Applicants respectfully submit that the cited prior art fails to anticipate or make obvious Applicants invention, as claimed for example, in pending claims 1-35. Applicants note for the record that the remarks above render the remaining rejections of record for the independent and dependent claims moot, and thus addressing individual rejections or assertions with respect to the teachings of the cited art is unnecessary at the present time, but may be undertaken in the future if necessary or desirable, and Applicants reserve the right to do so.<sup>2</sup>

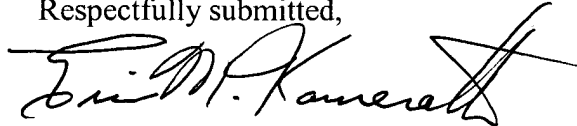
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<sup>2</sup>For example, the Office Action also asserts that asserts that at column 4, lines 60-67, *Augustine* discloses appending to separate storage locations the occurrence of successive events requested by individual client system in order to save a record of the occurrence of the events until notification is ready to be sent to the individual client system of the occurrence of all the saved events, as recited for example in independent claim 19. *See, e.g.,* Office Action, p. 10 (rejection of claim 19). Applicants respectfully submit, however, that this cited portion *Augustine* fails to teach, suggest, or motivate saving event notifications and then sending a single notification for all saved events. *See, e.g.,* Specification, p. 6, l. 17 – p. 7, l. 2. In addition to the reasons stated above, therefore, this and other distinctions provide independent bases for distinguishing over the cited art.

In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 15<sup>th</sup> day of July, 2004.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Eric M. Kamerath", with a stylized flourish at the end.

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